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No. 95-926

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

MARK I MARKETING CORPORATION and
MARK I MARKETING CORPORATION OF AMERICA,
Petitioners,

v.

R.R. DONNELLEY & SONS COMPANY,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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RESPONDENT'S BRIEF IN OPPOSITION

Of Counsel:
REX E. LEE
CARTER G. PHILLIPS
SIDLEY & AUSTIN
1722 Eye Street
Washington, D.C. 20006
(202) 736-8000

THOMAS F. RYAN
CONSTANTINE L. TRELA, JR.*
D. CAMERON FINDLAY
SIDLEY & AUSTIN
One First National Plaza
Chicago, IL 60603
(312) 853-7000

Counsel for Respondent

January 11, 1996

* Counsel of Record

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

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QUESTION PRESENTED

Whether summary judgment was properly entered in favor of respondent based on the doctrine of "prosecution history estoppel" where the courts below concluded that the relevant facts concerning the prosecution history of petitioners' patent were undisputed and that the meaning of the prosecution history was clear.

LIST OF PARTIES AND AFFILIATES

The caption of the case in this Court contains the names of all parties. The respondent has no parent companies or non-wholly owned subsidiaries.

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On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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RESPONDENT'S BRIEF IN OPPOSITION

Respondent R.R. Donnelley & Sons Co. ("Donnelley") respectfully submits this brief in opposition to the petition for a writ of certiorari filed by Mark I Marketing Corp. and Mark I Marketing Corp. of America (together, "Mark I"). Because the decision below was a correct and straightforward application of settled principles governing the entry of summary judgment and the doctrine of "prosecution history estoppel" to the specific facts of this case, this Court should deny the petition. Despite petitioners' transparent attempt to make it appear that this

case should be held pending disposition of *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir.) (*in banc*), *cert. granted*, 116 S. Ct. 40 (1995), the petition here presents no question at issue in *Markman* and, indeed, the court of appeals did not even mention *Markman* in its decision. The decision below was correct regardless of the ultimate disposition of *Markman*, and the petition therefore should be denied.

STATUTORY AND CONSTITUTIONAL PROVISIONS INVOLVED

Petitioners assert that this case involves two provisions of the United States Constitution: U.S. CONST., art. I, § 8, cl. 8, which provides Congress with authority to grant patents, and U.S. CONST., amend. VII, which guarantees a right to a jury trial in civil suits at law. (Petn. 2.) This case actually involves only the doctrine of "prosecution history estoppel" and FED. R. CIV. P. 56.

REASONS FOR DENYING THE PETITION

In the decision below, the Federal Circuit unanimously held that respondent was entitled to summary judgment because the "undisputed" facts established that, in the course of prosecuting the applications that resulted in the patent at issue in this case, Mark I had narrowed its patent claim in a manner that excluded Donnelley's accused process from the patent's scope. (Petn. App. 18a-19a.) This decision was nothing more than a straightforward and correct application of prosecution history estoppel, a doctrine which prevents a patentee from "obtain[ing], through litigation, coverage of subject matter relinquished during prosecution" of the patent application. *Zenith Laboratories, Inc.* v. *Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424 (Fed. Cir.), *cert. denied*, 115 S. Ct. 500 (1994). The question whether prosecution history estoppel in general should be determined as a matter of law or of fact was not relevant below because the Federal Circuit held that this case presented "no genuine issue of

material fact" under that doctrine. (Petn. App. 18a.) The Federal Circuit's application of prosecution history estoppel to the specific, undisputed facts of Mark I's patent prosecution does not create a conflict with any decision of this Court, the Federal Circuit, or any other court of appeals, and it does not raise any significant issue of law warranting this Court's attention.

Petitioners, recognizing that the decision below presents no issue worthy of this Court's review, attempt to recast the court of appeals' narrow, fact-specific application of prosecution history estoppel into a sweeping pronouncement on the "question of which issues in a patent case may be decided by the court, and which issues the court must leave to be decided after trial by the jury." (Petn. 7.) The obvious purpose of this recharacterization is to persuade this Court to hold this case on its docket pending its decision in *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir.) (*in banc*), *cert. granted*, 116 S. Ct. 40 (1995), a case which involves the issue whether the construction of patent claims is a question of law or fact. But this case presents no question under consideration in *Markman*. *Markman* involves only claim construction and not prosecution history estoppel; this case involves only prosecution history estoppel and not claim construction (because the meaning of the patent claim at issue was undisputed before the court of appeals). That is why the Federal Circuit's decision below did not discuss or even mention that court's earlier *in banc* decision in *Markman* or the other claim construction cases cited in the petition; the issues raised in *Markman* were and are irrelevant to the resolution of this case.

1. In its unanimous decision, the Federal Circuit simply applied the settled doctrine of prosecution history estoppel to the undisputed facts concerning Mark I's prosecution of its patent before the Patent and Trademark Office ("PTO"). The doctrine of prosecution history estoppel prevents a patentee from recapturing, through

litigation under the doctrine of equivalents,[1] a breadth of coverage for the patent's claims that the patentee surrendered while prosecuting the patent application. *See, e.g., Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126, 136-37 (1942); *Zenith*, 19 F.3d at 1421; *Haynes Int'l, Inc.* v. *Jessop Steel Co.*, 8 F.3d 1573, 1577-78 (Fed. Cir. 1993). Under the doctrine of prosecution history estoppel, the patentee's amendments to previously rejected patent claims, representations to the PTO, and arguments made to the PTO in order to obtain the patent—all of which are a matter of public record at the PTO (*Standard Oil Co.* v. *American Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985))—can estop a patentee from claiming in subsequent infringement litigation a broader scope for its patent than that which it led the PTO to believe it was seeking during the prosecution of its patent application. *See Haynes*, 8 F.3d at 1579; *Texas Instruments* v. *ITC*, 988 F.2d 1165, 1173-75 (Fed. Cir. 1993).

The court of appeals correctly stated and applied this doctrine in the decision below. Before the magistrate judge,[2] the district court, and the court of appeals, Don-

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[1] The doctrine of equivalents permits a patentee to maintain an infringement claim even where the accused product or process does not literally infringe the patent, if that product or process "performs substantially the same function in substantially the same way to achieve substantially the same result." *See Graver Tank & Mfg. Co.* v. *Linde Air Prods. Co.*, 339 U.S. 605, 608 (1951); *London* v. *Carson Pirie Scott & Co.*, 946 F.2d 1534, 1537 (Fed. Cir. 1991).

[2] The petition incorrectly states that the court of appeals decided the issue "on the basis of a cold appellate record" because "the doctrine of prosecution history estoppel . . . had not been the focus of the District Court's decision." (Petn. 5.) What the petition fails to disclose, however, is that Donnelley's motion for summary judgment had been referred in the first instance to a magistrate judge, and the magistrate judge, in a detailed report and recommendation, recommended that summary judgment be granted to Donnelley based on the doctrine of prosecution history estoppel. (*See* Opposition Appendix ("Opp. App.") 10a-13a.) The district

nelley argued that Mark I had surrendered during the prosecution of its patent application any claim to a two-color printing process that does not involve the use of (1) two printing plates, (2) each of which is prepared using the "sequential" interposition of two different-colored filters between the original image and the film. The court of appeals examined the undisputed prosecution history of the Mark I patent and agreed with Donnelley that it was entitled to judgment as a matter of law:

> The prosecution history demonstrates that Mark I was unsuccessful in obtaining allowance of the claims until they were narrowed to require that both the first and second printing plates be made by sequentially interposing particular combinations of colored filters. Moreover, during prosecution Mark I asserted that the claims were patentably distinguishable over the prior art based on these process steps.

(Petn. App. 17a.) Because it was undisputed that Donnelley's "accused process does not involve the sequential interposition of filters" but rather involves a "simultaneous" use of three filters in an electronic scanner, the court of appeals affirmed the district court's grant of summary judgment to Donnelley. (*Id.* at 19a.)

Petitioners' contention (Petn. 9-12) that this Court should grant the petition to resolve the purportedly unsettled question whether prosecution history estoppel is a question of law or fact (a) misrepresents the state of the law concerning prosecution history estoppel; (b) mischaracterizes the basis of the decision below; and (c) ignores the adequate and independent grounds for summary judgment in Donnelley's favor, grounds which make this case an extremely poor vehicle to decide the question stated in

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court did not "focus" on prosecution history estoppel only because it granted summary judgment on the alternative and sufficient basis that Mark I had presented no evidence to rebut Donnelley's showing that its accused process was already a part of the prior art at the time that Mark I obtained its patent. (Petn. App. 19a.)

the petition, even if that question were in fact presented in this case.

a. First, contrary to petitioners' assertion, there is no "uncertainty" or "confusion" in the Federal Circuit as to whether the application of prosecution history estoppel is a matter of law or fact. (*See* Petn. 11-12.) The Federal Circuit for years has consistently held that "the application of prosecution history estoppel is a question of law." *LaBounty Mfg. Co.* v. *ITC*, 867 F.2d 1572, 1576 (Fed. Cir. 1989).[3] No decision of the Federal Circuit or any other court has ever suggested that the application of prosecution history estoppel is not a matter of law, and petitioners do not and cannot cite any case so holding.

Indeed, the only two cases petitioners cite as evidence of the supposed "uncertainty" or "confusion" in the Federal Circuit—*Smithkline Diagnostics, Inc.* v. *Helena Laboratories Corp.*, 859 F.2d 878 (Fed. Cir. 1988), and *Hilton Davis Chemical Co.* v. *Warner-Jenkinson Co.*, 62 F.3d 1512 (Fed. Cir. 1995) (*in banc*), *cert. pending*, No. 95-728—did not even involve prosecution history estoppel, much less hold that it is a question of fact for the jury. *Smithkline* involved only the question whether claim interpretation is a matter of law or fact, and mentioned the prosecution history of the patent only as a potential aid to claim interpretation, not as a source of estoppel against the patentee. *See* 859 F.2d at 882, 884. Petitioners' professed confusion as to why *LaBounty* and the decision below did not "even mention[] *Smithkline*" (Petn. 9-11 & n.3) is thus easily resolved: *Smithkline* had nothing to do with prosecution history estoppel.

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[3] *Accord Southwall Technologies* v. *Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995); *Genentech, Inc.* v. *Wellcome Foundation*, 29 F.3d 1555, 1567 n.35 (Fed. Cir. 1994); *Hoganas AB* v. *Dresser Indus., Inc.*, 9 F.3d 948, 952 (Fed. Cir. 1993); *Texas Instruments*, 988 F.2d at 1173; *Loctite Corp.* v. *Ultraseal, Ltd.*, 781 F.2d 861, 870 (Fed. Cir. 1985).

Nor does *Hilton Davis* create any uncertainty as to whether application of prosecution history estoppel is a matter of law or fact. *Hilton Davis* involved only the question whether the determination of "equivalence" between an accused product or process and a patented invention under the doctrine of equivalents is a question of law or fact. *See* 62 F.3d at 1515, 1522. The Federal Circuit's holding, consistent with numerous prior decisions of this Court (*see, e.g., id.* at 1520-21, citing *Graver Tank*, 339 U.S. at 609-10) and the Federal Circuit, was that infringement under the doctrine of equivalents, like literal infringement, must be decided by the jury where genuine issues of material fact exist. *Hilton Davis*, 62 F.3d at 1522. *Hilton Davis* says nothing about "whether issues of prosecution history estoppel . . . should also be decided by the jury." (Petn. 9.) Nor does *Hilton Davis* "call the continued vitality of *LaBounty*, and any other decision holding that . . . prosecution history estoppel can be determined by the courts as a matter of law, into question." (*Id.* at 11.) To the contrary, infringement under the doctrine of equivalents has always been viewed as a question of fact (*see Hilton Davis*, 62 F.3d at 1520-28), just as the application of prosecution history estoppel has always been viewed as a question of law (*see supra* at 6 n.3). No conflict existed between these principles before *Hilton Davis*, and none exists now.

Put simply, there is *no* intracircuit "uncertainty" or "confusion" on the question Mark I raises in its petition. Every decision of the Federal Circuit to address the question has held that application of the doctrine of prosecution history estoppel is a matter of law, and the cases Mark I cites as evidence of "uncertainty" or "confusion" did not address that question in the least.

b. Second, petitioners' suggestion that the decision below depended upon a holding that application of prosecution history estoppel is a question of law mischaracterizes that decision. The Federal Circuit correctly stated in an

introductory paragraph the principle that "[t]he application of prosecution history estoppel is a question of law" (Petn. App. 16a), but this principle ultimately was unnecessary to the court's decision, because the Federal Circuit held that petitioners had not raised *any* "genuine issue[] of material fact precluding a grant of summary judgment" (*id.* at 18a). The court applied ordinary summary judgment principles, viewing the evidence in the light most favorable to Mark I and resolving any doubts in Mark I's favor (*id.* at 8a-9a), and concluded that "the relevant facts here are undisputed" (*id.* at 18a), and thus "no reasonable factfinder could find that the accused process infringes the [Mark I] patent" (*id.* at 19a). Even now, although petitioners repeatedly assert that the Federal Circuit improperly resolved "factual issues" or "issues of fact" that should have gone to a jury (*e.g.*, Petn. 5, 6, 7, 9, 10 n.3, 12), they do not even attempt to identify any specific disputed factual issue that the courts below improperly decided.

In short, even if, as petitioners contend, application of prosecution history estoppel can present questions of fact, the court of appeals properly affirmed the entry of summary judgment in Donnelley's favor in this particular case. Where, as here, the evidence reveals the existence of no genuine issues of material fact, summary judgment is appropriate regardless of whether the underlying question is generally a matter of law for the court or fact for the jury. *See Celotex Corp.* v. *Catrett*, 477 U.S. 317, 325 (1986); *Anderson* v. *Liberty Lobby, Inc.*, 477 U.S. 242, 254-55 (1986).[4] Therefore, even if uncertainty actually existed as to whether application of prosecution

[4] That the decision below represents a routine application of FED. R. CIV. P. 56 to undisputed facts rather than a pronouncement on the Seventh Amendment rights of patent litigants is underscored by the fact that Judge Mayer, who vigorously opposed the decision in *Markman* to commit claim construction exclusively to the court (*see* 52 F.3d at 989-98), joined the opinion in this case without comment.

history estoppel in general is a matter of law or fact, that issue is not presented and could not properly be resolved in this case.

c. Finally, even if there were "uncertainty" or "confusion" as to whether application of prosecution history estoppel is an issue of law or fact (and there is not), and even if the decision below squarely posed that question for this Court's review (and it does not), this case would be an extremely poor vehicle by which to decide that question, because an independent and adequate ground exists to affirm the Federal Circuit's judgment: the district court's separate holding that Donnelley's accused process was found in the "prior art" well before Mark I's patent issued. It has long been settled that a patentee may not assert infringement by expanding the scope of its patent's claims so as to "read on the prior art," that is, to encompass products or processes already in existence at the time the patent issued. *See, e.g., We Care, Inc.* v. *Ultra-Mark Int'l, Inc.*, 930 F.2d 1567, 1571 (Fed. Cir. 1991). In this case, as Mark I concedes (Petn. 4, 6), the district court granted summary judgment to Donnelley on the independent ground that Mark I had failed to come forward with any evidence to refute Donnelley's showing that its accused process was already part of the prior art at the time of Mark I's patent (Petn. App. 34a-35a). The Federal Circuit did not reach this alternative ground because it held that Donnelley was entitled to summary judgment under the prosecution history estoppel doctrine. (*Id.* at 19a.) Accordingly, because this Court could affirm the Federal Circuit's judgment on the independent, alternative ground employed by the district court, this case is not an appropriate one in which to attempt to resolve the question stated in Mark I's petition.[5]

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[5] In apparent recognition of the fact that the district court's holding provides an adequate and independent ground to affirm the judgment, petitioners briefly suggest that they also seek to have this Court grant certiorari to determine whether the district court

2. Nor is there any reason to hold this case pending this Court's decision in *Markman*. Although petitioners strive mightily to force this case into the *Markman* mold, the simple fact is that *Markman* and this case address entirely different issues, and thus this case would be unaffected by any decision this Court could reach in *Markman* later this Term.

Markman involves the question whether "the interpretation or construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of law exclusively for the Court." 52 F.3d at 970. *See also id.* at 976 ("It is the first step, commonly known as claim construction or interpretation, that is at issue in this appeal."). In answering that question affirmatively, the *in banc* Federal Circuit surveyed its own previous decisions on the construction of patent claims (*id.* at 976-77), this Court's decisions on the construction of patent claims (*id.* at 977-78), and various policy reasons for construing patent claims as a matter of law and not fact (*id.* at 978-79). Based on this survey, the Federal Circuit held "that in a case tried to a jury, the court has the power and obligation to construe as a matter of law the meaning of language used in the patent claim." *Id.* at 979. *Markman* did not address prosecution history estoppel at all. Indeed, the *Markman* court discussed the

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erred by granting summary judgment in the face of "directly conflicting witness and expert affidavits" on the prior art issue. (Petn. 6.) As an initial matter, determining whether the district court applied the settled summary judgment standards of FED. R. CIV. P. 56 to the facts of this case is plainly not an issue worthy of this Court's review. Moreover, the district court's decision was plainly correct. Even after the magistrate judge expressly warned petitioners that they had failed to present any evidence on the prior art issue and thus risked summary judgment (Opp. App. 14a-15a), petitioners still failed to offer any evidence that Donnelley's process was not found in the prior art (Petn. App. 34a-35a). Even now, although the petition again alludes generally to the existence of factual disputes, it does not identify any submissions creating a material factual dispute that would preclude summary judgment with respect to this alternative ground. (Petn. 6.)

prosecution history of the patent there at issue only as an aid "to understand the language in the claims" (*id.* at 980), not as a source of estoppel under the prosecution history estoppel doctrine.

The Federal Circuit's decision in this case, on the other hand, turned solely on prosecution history estoppel. (*See* Petn. App. 10a-19a.) The court held that Mark I was estopped by its statements and actions in the PTO from claiming, under the doctrine of equivalents, that its patent covered processes, like Donnelley's, that did not involve the "sequential" use of two filters. (*Id.* at 19a.) The court below did not address any issue of claim construction, because the only claim construction issue presented at any point in the proceedings below—whether the claim term "sequentially" meant (as Donnelley contended) "one after the other" or (as Mark I contended) "not stacked one on top of the other" (*id.* at 29a-31a)—had already been resolved in Donnelley's favor by the district court (*id.* at 30a-31a) and was not appealed by petitioners to the Federal Circuit (*see id.* at 9a). In short, the prosecution history estoppel question resolved by the Federal Circuit below was entirely different than the claim construction question raised in *Markman*. That is why the Federal Circuit did not even mention in its decision below its earlier *in banc* decision in *Markman* or any of the other claim construction cases surveyed in the *Markman* opinion.

Indeed, the courts have always drawn a distinction between the use of prosecution history as an aid to claim construction and the use of prosecution history to estop a patentee, a distinction that Mark I's petition tries hard to blur. In *Loctite Corp.* v. *Ultraseal, Ltd.*, 781 F.2d 861 (Fed. Cir. 1985), the Federal Circuit explained that using prosecution history to interpret claims and using it to estop a patentee from claiming broad coverage for its patent under the doctrine of equivalents are two different things:

> Prosecution history estoppel is relevant here to the statements made by [the patentee] during the '012 patent prosecution to circumvent prior art . . . . *Though the same statements were used to interpret the claims in view of the prosecution history, the two doctrines are to be distinguished. Interpreting claims in view of the prosecution history applies as a preliminary step in determining literal infringement. Prosecution history estoppel applies as a limitation to the doctrine of equivalents after the claims have been properly interpreted and no literal infringement has been found.*

Id. at 870 (emphasis added). *See also id.* at 871 (although courts can look to the prosecution history to interpret claims, "[i]n the prosecution history estoppel context, different considerations apply").[6]

In sum, there is no basis to hold this case pending this Court's decision in *Markman*. The Federal Circuit's decision here did not involve any question of claim construction, but instead involved only the separate question of prosecution history estoppel. Therefore, contrary to petitioners' assertions, even if this Court were to reverse the decision in *Markman* and hold that claim construction is a question of fact that must be decided by a jury, it would create no "legal anomaly" (Petn. 12) for petitioners. Whether claim construction is held to be a question of fact or a question of law, the result in this case would still be the same—petitioners would be estopped as a matter of law from claiming that Donnelley's process infringed their patent because they relinquished any such claim during the prosecution of that patent.

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[6] *Accord Read Corp.* v. *Portec, Inc.*, 970 F.2d 816, 823-25 (Fed. Cir. 1992); *Biodex* v. *Loredan Biomedical, Inc.*, 946 F.2d 850, 862-63 (Fed. Cir. 1991); 4 D. CHISUM, *Patents* § 18.05[4] (1995).

CONCLUSION

For the reasons stated above, respondent respectfully requests that the Court deny the petition for certiorari.

Respectfully submitted,

Of Counsel:
REX E. LEE
CARTER G. PHILLIPS
SIDLEY & AUSTIN
1722 Eye Street
Washington, D.C. 20006
(202) 736-8000

THOMAS F. RYAN
CONSTANTINE L. TRELA, JR.*
D. CAMERON FINDLAY
SIDLEY & AUSTIN
One First National Plaza
Chicago, IL 60603
(312) 853-7000

Counsel for Respondent

January 11, 1996

* Counsel of Record

APPENDIX

APPENDIX

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

No. 92 C 8380

MARK I MARKETING CORPORATION, and MARK I MARKETING CORPORATION OF AMERICA,
Plaintiffs,

vs.

R.R. DONNELLY & SONS COMPANY,
Defendant.

HONORABLE GEORGE W. LINDBERG,
JUDGE UNITED STATES DISTRICT COURT

HONORABLE JUDGE:

REPORT AND RECOMMENDATION
of Magistrate Judge Edward A. Bobrick

Before the court is the motion of defendant R.R. Donnelly & Sons Company ("Donnelly") for summary judgment on Count I of the complaint of plaintiffs Mark I Marketing Corporation ("MIC") and Mark I Marketing Corporation of America ("MICA").

In Count I of their complaint, plaintiffs allege that defendant has infringed U.S. Patent No. 4,554,241 originally issued to Wallace Edwards ("Edwards Patent"). The Edwards patent describes a process of printing lifelike color pictures using just two different inks. According to plaintiffs' complaint, this process is well-suited to the

thin paper stock which defendant uses to print its Yellow Pages telephone directory, and defendant makes use of the process despite plaintiffs' objections. Defendant has moved for summary judgment, arguing that there is no genuine issue of fact as to its noninfringement of the Edwards patent because it "does not do what the words of the patent claims describe." (Donnelly's Memorandum in Support, at 1). We examine the record as it presently stands to determine whether summary judgment is appropriate in this matter.

I. BACKGROUND

The parties have provided us with some history of the printing processes used to render multi-color reproductions of photographs or artwork. Generally, the subject photograph or artwork is photographed through four different filters, each drawing out a separate hue from the subject: yellow, magenta, cyan, or black. From these four separate images, four separate printing plates are made, each one corresponding to a color. Transparent inks of those colors—called process inks—are then used on the corresponding plates. Next, the colors are printed in turn, one on top of another, to achieve a result that exhibits a wide array of shading and blending of hues. The process is generally called "four color process" printing. The "four color process" is difficult to apply in the Yellow Pages industry, however, because of expense and limitations owing to the paper stock used. For example, Yellow Page stock is of relatively low quality and does not receive the four overlapping inks very well. The Edwards patent represents a solution to this problem: the plaintiffs call it a "breakthrough;" the defendant calls it an "alternative."

A. *Facts*

We draw the material facts of this case from the parties' Local Rule 12 submissions. The inventor of the patent-in-suit, Wallace Edwards, filed his first patent application before the U.S. Patent and Trademark Office

("Patent Office") as Serial No. 485,668 ("No. '688") in April 18, 1983. No. '668 described a method that called for:

> making a first film and plate to print a first ink having a hue corresponding to the colour predominating in the original,
>
> making a second film and plate to print a second ink having a hue that in relation to the first ink against the sheet gives the impression of a third hue, not present in either the first or second inks,
>
> coating the plate with their respective inks and printing the sheet.

(Donnelly's Rule 12(m) Statement "12(m) St."), ¶ 11). The Patent Office rejected Edwards' claim as anticipated by, and obvious in light of, a 1978 *DuPont Magazine* article on two-color printing on colored paper. While Edwards did not respond to the rejection, he filed a continuation-in-part, Serial No. 595,815, on April 2, 1984, in which he claimed:

> creating a first printing plate by the interposition of at least two filters between the original and the means for recording a first image,
>
> creating a second printing plate by the interposition of at least one filter between the original and means for recording a second image, and
>
> using the plates to print different impressions with two different coloring media.

(*Id.* at ¶ 13). Edwards then voluntarily amended his claim on June 8, 1984, as follows:

> creating a first printing plate by the *sequential* interposition of at least two *different colour* filters between the original and means for recording a first optical image,
>
> creating a second printing plate by the interposition of at least one filter between the original and means for recording a second optical image,

> and using said first and second plates to print the said different impressions with two different colouring media.

(*Id.* at ¶ 14 (emphasis in original)). On July 9, 1984, Edwards filed a "Renewed Petition to Make Special Under 708 (VIII) of M.P.E.P.," acknowledging prior art which simulated standard, four-color process printing with less than a four-color separation process. Edwards distinguished his process on the basis of sequential double exposure of film:

> "The applicant . . . has discovered an alteration in the film-producing step typically employed in the four-colour separation process which alteration is such as to allow a stunningly realistic reproduction of an original in only two inks . . .
>
> The alteration mentioned above involves, in the case of the use of film, the double exposure of the film using two different filters sequentially."

(*Id.* at ¶ 15). Edwards' Renewed Petition to Make Special then distinguished five separate prior art patients—Milligan, Laber I, Larber II, Larber III, and Larber IV—on the basis of the Edwards patent's use of the "sequential interposition of at least two different color filters between the original and means for recording a first optical image." (*Id.*, Ex. H, at 28-30). Thus, Edwards distinguished each one on the basis that it did not disclose creating a first printing plate by the *sequential interposition* of a least two different color filters between the original and the film: a means for recording a first optical image. The Patent Office rejected the claims of Serial No. 595,815 ("No. '815") in part as being "obvious" in light of the *DuPont Magazine* article described above and *The Lithographers Manual.* Edwards did not respond to the Examiner's rejection of Serial No. 595,815, but instead filed a second continuation-in-part, Serial No. 712,659, ("No. '659") on March 19, 1985. That application was allowed without comment by the Examiner. (*Id.*, Ex. H,

pp. 38-42). Claim 1, which is the focus of this litigation, reads as follows:

1. A method of printing on a sheet member a realistic reproduction of a colored original, utilizing a minimum of two different superimposed impressions, each with a different coloring medium, comprising:

a) providing a colored original,

b) creating a first printing plate intended to print a nonprocess red color, by

1) making a green filter exposure of the original on a first means for recording a first optical image,

2) making a blue filter exposure of the original on said first means,

steps 1) and 2) being carried out sequentially on any order,

c) creating a second printing plate intended to print a second color different from that printed by said first plate, by

3) making a red filter exposure of the original on a second means for recording a second optical image,

4) making a blue filter exposure of the original on said second means,

steps 3) and 4) being carried out sequentially in any order,

steps b) and c) being carried out in any order,

d) providing a sheet member to receive two superimposed impressions, and

e) using said first and second printing plates to print said red color and said different color,

> respectively, as the said superimposed impressions on said sheet member.

(12(m) St., Ex. H).

According to Donnelly, it has used many different processes to print color images. Donnelly submits, however, that these processes have never involved:

> creating a printing plate intended to print a non-process red color by making a sequential green filter exposure and a blue filter exposure of the original image on a film (or other means), and
>
> creating a printing plate by making a sequential red filter exposure and blue filter exposure of the original image on a film (or other means).

(*Id.*, at ¶ 18). Plaintiffs disagree with Donnelly's position. Specifically, plaintiffs argue the Donnelly utilized the Edwards process for color printing on yellow paper. Specifically, plaintiffs charge that Donnelly makes a plate to print non-process red ink by making a film with a green and a blue filter, and a plate to print non-process blue ink by making a film with both red and blue filters. (Plaintiffs' Rule 12(m) Response ("Pl. Resp.") at ¶ 18). Plaintiffs contend that this is the same process as that described in claim 1, paragraphs b, c, d, and e, of the Edwards patent. (*Id.*; *see supra* at 5a-6a). Plaintiffs' contentions are based on the Affidavit of Miles Southworth, a printing expert and consultant.

Donnelly states that a firm called Flying Color Graphics prepares the separations Donnelly uses in its Yellow Pages printing on a commercially available Crosfield scanner. In the process, according to Donnelly, the film is neither double-exposed nor sequentially double-exposed. The Crosfield scanner operates as follows:

> (a) A single white light shines on a small area of the colored original called a "picture element," or "pixel" for short. That light is reflected into

the scanner, where a beam splitter splits the reflected light into three beams which are filtered (simultaneously, not sequentially) through red, green, and blue filters, respectively. The scanner then measures the intensity of the resulting red, green, and blue beams and that information is converted into electrical voltages. Those voltages are further converted (again, simultaneously, not sequentially) into digital values (numbers); *i.e.*, the red, green, and blue color information is "digitized." That information is then stored in memory and processed as described below. The scanner repeats this process for each pixel until the completed original has been scanned. (12(m) St., Ex. D, ¶ 12).

(b) On the output side, the separation film is exposed only once; *i.e., the film is not double exposed, much less sequentially double exposed as the patent requires.* Briefly, the three respective digital values for the red, green, and blue information for a pixel are analyzed together and in relation to one another (again simultaneously, not sequentially) using complicated algorithms derived by the scanner manufacturer which calculate the size and density of the different colored dots of ink which must be laid down in order to simulate the color in the original. Of course, the size and density of those dots depend on the precise colors and types of inks to be used in the final printing stage (and on other factors, such as the color of the paper to be printed on). Therefore, the Crosfield scanner has certain "color correction" functions which allow the scanner operator to adjust for different inks or paper. These functions use conversion, or "look up," tables to replace the digitized red, green, and blue color information with four new digital values which

> represent the amount of each of the printing inks which must be used to reproduce the shade and hue of the original pixel. This adjusted digitized information is then used to generate electrical impulses which are sent to lamps (or lasers) and which tell those lamps (or lasers) where to expose tiny spots on the separation negatives to create the required number, size and density of dots on each of the four separations. Each tiny spot on each film falls under the exposing light once and only once and is either fully exposed or not exposed at all. Printing plates are then created from the separations. (12(m) St., Ex. D., ¶ 13).

Plaintiffs argue that the Crosfield scanner, although commercially available, may be adjusted to utilize the Edwards patent process. (Pl. Resp. ¶ 21). Further, plaintiffs submit that the claims of the Edwards patent do not require the film be double-exposed; any double-exposure or sequential interposition language refers to the use of photographic equipment as opposed to a scanner. (Pl. Resp., ¶ 21).

B. *Parties' Positions*

According to Donnelly, an essential element of the Edwards patent is the sequential interposition of at least two different color filters between the original and the means for recording the first optical image. Donnelly submits that its process—involving the Crosfield scanner—does not practice this claim. Plaintiffs submit that, while Donnelly does not literally infringe the claim, it does practice a process that is equivalent to the claim and, therefore, must be considered to be infringing.

Donnelly contends that two rules of law prevent the application of plaintiffs' doctrine of equivalents argument to the instant case. First, Donnelly submits that "prosecution history estoppel" precludes plaintiffs from arguing that the sequential interposition of filters is unnecessary

to the Edwards patent. Second, and similarly, Donnelly also contends that what plaintiffs cannot do what they seek to do through the doctrine of equivalents: expound the Edwards patent to "read as prior art." Accordingly, Donnelly argues that, as a matter of law, it is entitled to summary judgment on Count I of plaintiffs' complaint.

II. ANALYSIS

Summary judgment is appropriate when "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The moving party bears the burden of demonstrating the absence of genuine issues of material fact. *Conroy v. Reebok Intern., Ltd.*, 14 F.3d, 1570, 1575 (Fed. Cir. 1994). The moving party, however, need not produce evidence showing the absence of a genuine issue of material fact but rather may discharge its burden by showing the district court that there is an absence of evidence to support the nonmoving party's case. *Id.* Here, Donnelly seeks to show there is an absence of evidence to support plaintiffs' charges of infringement.

The determination of infringement is a two-step process: first, the court interprets the claim to determine its meaning and scope; second, the court determines whether the accused device or process is within the scope of the property construed claim. *Dolly, Inc. v. Spalding & Evenflo Companies, Inc.*, 16 F.3d 394, 397 (Fed. Cir. 1994). It is the plaintiff's burden to demonstrate infringement by establishing that the accused device or process include every limitation of the claim or an equivalent of each limitation. *Id.* Here, plaintiffs argue that Donnelly's process is the equivalent of the Edwards patent process: specifically, that Donnelly's process infringes every step of the Edwards patent claim 1, except that the filter ex-

posures for the film are not made sequentially. (Pl. Resp., Ex. A, ¶ 8).

Under the doctrine of equivalents, an accused device or process may infringe a claim if it performs substantially the same overall result as the claimed invention. *Id.* The element substituted in the accused device for the element set forth in the claim must not be such as would substantially change the way in which the function of the claimed invention is performed. *Id.* The parties would appear to agree that a determination as to whether Donnelly has infringed the Edwards patent under the doctrine of equivalents is inappropriate in the context of this summary judgment motion. Donnelly, however, submits that the application of the doctrine of equivalents is barred by two legal doctrines: "prosecution history estoppel" and "reading on the prior art."

A. *Prosecution History Estoppel*

Prosecution history estoppel prevents a patentee from obtaining, through litigation, coverage of subject matter relinquished during prosecution of the patent. *Haynes Intern., Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1577 (Fed. Cir. 1993). The legal standard for determining what subject matter has been relinquished is objective: what was a competitor reasonably entitled to conclude, from the prosecution history of the patent, that the patent applicant gave up in order to procure the issuance of the patent. *Id.* Donnelly argues that the history of prosecution of the Edwards patent precludes plaintiffs from abandoning the requirement of a *sequential* exposure of film in order to record the image. It would follow, from this premise, that Donnelly does not infringe the process because its use of the Crosfield scanner does not involve a sequential exposure of film. The issue, then, is whether the sequential exposure of film is a required element of th Edwards patent.

Plaintiffs advance several arguments against the application of prosecution history estoppel in this case. First,

and foremost, plaintiffs submit "that only arguments advanced, and necessary, to overcome cited prior art" estop the recapture of subject matter relinquished by the amendment. Plaintiffs offer no citation in support of this proposition and, indeed, it would appear that the law is otherwise. In *Texas Instruments, Inc. v. U.S. Intern. Trade Com'n*, 988 F.2d 1165 (7th Cir. 1993), the court indicated that prosecution history estoppel was, as a general rule, based on the amendment of a claim to avoid a prior art reference, but also indicated, further, that "[u]nmistakeable assertions . . . in support of patentability, whether or not required to secure the allowance of the claim, also may operate to preclude a patentee from asserting equivalency between a limitation of the claim and a substituted structure or process stop." 988 F.2d at 1174. More specifically, there is a broad range of activities taken before the patent office that can give rise to prosecution history estoppel, including: statements contained in a disclosure document in the PTO file; representations made during the presentation of the patent application; remarks made during the prosecution of a claim not in suit; statements made after the examiner indicated the claims were allowable. *Haynes Intern., Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 1579 (Fed. Cir. 1993). (footnotes omitted). An estoppel can arise even though the claim, which is the basis for the assertion of the doctrine of equivalents, was not amended during prosecution. *Id.* Plaintiffs' premise for rejection of Donnelly's motion, then, is based on far too narrow a reading of the law. Thus, plaintiffs' argument that prosecution history estoppel is inapplicable to this case because the language at issue was voluntarily added is of no moment to resultion of this issue.

From this faultily narrow premise, plaintiffs proceed to argue that the language at issue, referring to the sequential interposition of at least two different filters, is irrelevant to any prior art or prosecution history. It would appear that plaintiffs' argument in this respect is based on the

fact that Edwards abandoned No. '815, in which he used the language at issue to distinguish prior art, and that the second continuation-in-part, No. '659, was allowed without comment. As noted above, however, even if the subject claim goes unamended during prosecution, prosecution history estoppel can still apply.[1] Here, it is beyond dispute that the Edwards patent claims, at 1(b), the "making a green filter exposure of the original on a first means for recording a first optical image" and "making a blue filter exposure of the original on said first means," requiring the sequential interposition of filters. In connection with Edwards' preceding petition, which admittedly was abandoned, this sequential interposition was the single most distinguishing factor with respect to prior art. We feel that, in light of the holdings in *Haynes* and *Texas Instruments*, the emphasis Edwards placed on this claim during the proceedings before the PTO ultimately leading to the Edwards patent preclude the application of the doctrine of equivalents in this matter. While this may not amount to "a classic example of prosecution history estoppel—an amendment in response to a prior art rejection," *Haynes*, 8 F.3d at 1579, it is sufficient given the present case law interpreting the scope of the doctrine. It cer-

[1] In *Texas Instruments*, for example, the court focused on the interaction between the inventors and the PTO during the prosecution of a "grandparent" application. There, the patent-in-suit stemmed back fourteen years to an original application. That application was superseded by a "patent" application and a continuation which matured into the patent-in-suit. 988 F.2d at 1173-74. Despite the intervention of fourteen years and two applications, the court found that the patentee surrendered certain claims in order to distinguish prior art during the prosecution of the grandparent application that could not be reclaimed. 988 F.2d at 1175. This was, simply put, part of the record made in the PTO upon which other players in the marketplace were entitled to rely. *Id.* Here, similar players must be entitled to rely on the emphasis Edwards placed on "sequential interposition" in prosecuting the predecessor application to the Edwards patent. That emphasis, like the statements in *Texas Instruments*, is part of the record made in the PTO.

tainly indicates, contrary to plaintiffs' assertions, that the language at issue is not "irrelevant" to the Edwards patent.

Before dispensing with discussion of the issues of prosecution history estoppel and the doctrine of equivalents, we return briefly to the applicable legal standard. Plaintiffs' insinuations notwithstanding, the standard is, as already noted, an *objective* one. *Supra,* at 10a (*citing Haynes,* 8 F.3d at 1578). The test is drawn from the standpoint of a competitor's reasonable conclusions given the entire prosecution history of the patent. *Id.* Here, in connection with the petition that preceded the Edwards patent, there was what could only be characterized as emphasis placed on the sequential interposition language. This language then became central to claim 1 of the Edwards patent. Review of this history would certainly allow a competitor to reasonably conclude that the language at issue was a necessary requirement of the Edwards patent. Prosecution history estoppel, then, precludes plaintiffs from asserting the doctrine of equivalents in this case. Accordingly, we cannot find a material issue of fact precludes the entry of summary judgment in Donnelly's favor based on prosecution history estoppel.

B. *Reading on the Prior Art*

Because we dispose of this matter under the prosecution history estoppel doctrine, we need not resolve the issue of whether plaintiffs improperly seek to expand the claims of the Edwards patent to "read on prior art." For the sake of thoroughness, however, we will briefly address Donnelly's argument in this regard. Essentially, Donnelly argues that it has used the accused method for printing for many years; that plaintiffs are accusing Donnelly of infringement for engaging in a widely-used practice that is well-known in prior art. In short, according to Donnelly, plaintiffs are attempting to expand the scope of the Edwards patent, through the doctrine of equivalents, to "read on prior art."

It is true, as Donnelly suggests, that prior art restricts the range of the doctrine of equivalents. *We Care, Inc. v. Ultra-Mark Intern. Corp.*, 930 F.2d 1567, 1570 (Fed. Cir. 1991). Since prior art limits what an inventor *could have* claimed, it also limits the range of permissible equivalents of a claim. *Id.* (emphasis added). Thus, a determination on this issue must include consideration of whether the range of equivalents asserted by the patentee encroaches on prior art. *Id.* at 1570. This involves consideration of what prior art would have anticipated, what it would have made obvious at the time the patentee filed the original application. *Id.* Obviousness and anticipation both involve factual issues that are ordinarily not amendable to summary judgment. *Id.*; *Chester v. Miller*, 906 F.2d 1574, 1576 (Fed. Cir. 1990). In this case, especially since we dispose of this matter under another theory, we are hesitant to render a decision on Donnelly's "prior art" theory due to the factual issues involved. We note, however, that it would appear that plaintiffs have failed to adequately address this theory in their submissions on this matter.

As we interpret it, Donnelly's argument is based on the fact that the process it uses—involving a scanner and two non-process inks—had been used for some time in the printing industry. (Rule 12(m), ¶¶ 21-26). Thus, according to Donnelly, plaintiffs' arguments that this process infringes the Edwards patent necessarily involve an expanion of the Edwards patent's claims to include long-known processes that were part of the prior art. Rather than address this argument, plaintiff submit that Donnelly is attempting to have the Edwards patent declared invalid. (Memorandum in Opposition, at 25-26). Because Donnelly does not make such an argument anywhere in its submissions, plaintiffs have left themselves open to an entry of summary judgment on this issue in Donnelly's favor for their failure to adequately respond to Donnelly's motion. Nevertheless, we feel that plaintiffs' misapprehension of the issue has left the record in-

sufficiently developed on the question of "reading on the prior art." Accordingly, we choose not to rule on this issue at this time.

III. CONCLUSION

Donnelly has submitted two legal arguments in favor of summary judgment. We decline to rule on the second—that plaintiffs seek to expand the claims of the Edwards patent to "read on the prior art" through the doctrine of equivalents—due to the inadequate development of the record relating to that issue. Donnelly's first argument—that "prosecution history estoppel" precludes plaintiffs' use of the doctrine of equivalents in this case—does not involve any factual issues and is adequate to support summary judgment in this matter. In short, plaintiffs' stance that the "sequential interposition of filters"—the double exposure of film—is not a necessary element of Edwards patent is unsupported by the record before the PTO. Based on that record, a competitor could reasonably conclude that "sequential interposition" was indeed a required element. Accordingly, prosecution history estoppel precludes plaintiffs from arguing that Donnelly's process—which admittedly does not include "sequential interposition"—infringes the Edwards patent.

For the foregoing reasons, it is hereby recommended that the defendant's motion for summary judgment on Count I of plaintiffs' Complaint be granted.

Respectfully submitted,

/s/ Edward A. Bobrick
EDWARD A. BOBRICK
United States Magistrate Judge

DATE: June 10, 1994